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09/748,729	12/26/2000	Lawrence E. Williams III	23088 0276046	4226

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EXAMINER
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ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/748,729

Applicant(s)

WILLIAMS, LAWRENCE E.

Examiner

James H Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 March 2004 has been entered.

### ***Response to Amendment***

On 26 March 2004, Applicant cancelled claims 1, 2, 4-9, 11-19 and added claims 20-33.

The amendment failed to list the status of claims 3 and 10, which were cancelled on 30 June 2003. Applicant is reminded that 37 CFR 1.121 requires a complete listing of all claims.

Claims 20-33 are pending and will be examined.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the on-board database must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20, 27 and claims dependent thereupon are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims originally filed and pages 18-22 of the specification as filed and as amended fail to describe an on-board database.

Similarly, the disclosures fail to describe the following steps:

- ***requesting*** the medical log of the customer from the virtual garage using the telematics device...;
- ***receiving*** the medical log of the customer from the virtual garage to the telematics device of the customer vehicle;
- ***storing*** the medical log in an on-board database associated with the telematics device of the vehicle;

- **transmitting** the medical log of the customer to a Public Service Answering Point, wherein the medical log is transmitted from the on-board database associated with the telematics device of the customer vehicle to the Public Service Answering point.

The disclosures fail to describe transmitting the medical log of a customer to a Public Service Answering Point where the PSAP comprises an emergency medical service vehicle, as in claims 26 and 33.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 27, 31 and 32, the word "means for" appear to be an attempt to invoke 35 U.S.C. 112, sixth paragraph, to recite claim element as a means for performing a specified function. However, since the disclosures provide no structural support for the claims, it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claims 20-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to "medical log" of a customer. While the term is mentioned in various places, applicants do not define what information is contained in the medical log. For purposes of this examination, the term "medical log" will be given its broadest

reasonable interpretation to include *any* type of information concerning a customer's health, including any type of medical information or history.

The claims also refer to "medical roadside emergency." Applicant fails to define what constitutes a "medical roadside emergency." For purposes of this examination, the term "medical roadside emergency" will be given its broadest reasonable interpretation to include any type of situation where a customer feels he has need of *any* type of medical care.

### ***Double Patenting***

Claims 21 and 28 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 20 and 27. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 20-33 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Kennedy III et al. (US Patent 6,535,743)/**Kennedy** in view of Suman et al. US Patent 6,028,537/**Suman** and further in view of "InfoGation Corp. Introduces Productivity, Navigation, Safety and Communication Software Applications for Next-Generation

Smart Car Systems," PR Newswire, New York, January 8, 1998, downloaded from the Internet on 10 April 2003/*InfoGation*.

*Kennedy* discloses providing through an electronic medium information, including a medical log of a customer, using a telematics device embedded in a customer vehicle.

**As per claims 20 and 27**, *Kennedy* discloses

**establishing** a communication link between a telematics device and a virtual garage, wherein the virtual garage comprises at least one server on the Internet and wherein the virtual garage stores information, including medical information of a customer. See, for example, *Kennedy*, at least Col. 9, lines 12-48. See also at least Col. 15, lines 7-11.

**requesting** information, including medical information, of a customer from a virtual garage using a telematics device. See, for example, *Kennedy*, at least Col. 5, lines 7-18, Col. 11, line 21-Col. 12, line 26.

**receiving** customer information from a virtual garage to the telematics device of a customer vehicle. *Kenney* discloses downloading information from a service center to a vehicle's telematics device, See, for example, at least Col. 9, line 49-Col. 10, line 11.

**storing** information, including medical information, in an on-board database associated with the telematics device of the vehicle. See, for example, *Kennedy*, at least Fig. 1, item 40, and related text, Col. 4, line 46-Col. 5, line 3. Memory 40 includes various *[on-board] databases* that store information for its various functions.

**transmitting data** to/from a vehicle's telematics device and service providers. See, for example, *Kennedy*, Col. 13, lines 1-19. Please note that while *Kennedy* **does**

**not** specifically say "...transmitting medical information of a customer to a Public Service Answering Point, wherein the information is transmitted from the on-board database associated with the telematics device of the customer vehicle to the Public Service Answering point..." Kennedy discusses the use of 911 numbers. For example, Col. 5, lines 48-58. **911** is an emergency reporting system whereby a caller can dial a common number for all emergency services. The caller will be answered at a common answering location (public service answering point - PSAP)<sup>1</sup> which figures the nature of the emergency and dispatch the proper response teams.

Kennedy **does not** specifically disclose "...receiving medical information..." from a virtual garage to the telematics device of a customer. It is well known that a person's medical history may change over time; a patient who has a heart condition may also develop diabetes, for example. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kennedy and knowledge generally available to disclose receiving medical information of a customer from a virtual garage to the telematics device of a vehicle. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Kennedy and knowledge generally available to disclose receiving medical information of a customer from a virtual garage to the telematics device of a vehicle for the obvious reason that a person's medical history may change over time and it would be important to have the latest information on a person should that person become involved in an accident.

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<sup>1</sup> PSAP is a generic term for the person or group of people who answer 911 emergency phone calls. Newton's Telecommunications Dictionary.



**As per claims 21 and 28**, Kennedy discloses use of the Internet. See, for example, Col. 7, line 47-Col. 8, line 3.

**As per claims 22 and 29**, Kennedy discloses that communication link may be though wireless connections. See, for example, at least Col. 7, line 66-Col. 8, line 3. See also at least Col. 8, line 55-Col. 9, line 5.

**As per claims Claim 23 and 30**, Kennedy **does not** mention transmitting information, including medical information, from a virtual garage to a telematics device using an FM subcarrier network. It is well known that information may be transmitted from TSP's to telematics devices via FM subcarrier networks. For example, InfoGation discloses that CUE's FM subcarrier network reaches over 80% of the North American population and interstate highway system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kennedy with InfoGation and disclose transmitting information from a portal to a customer device over an FM subcarrier network. One of ordinary skill in the art at the time the invention was made would have been *motivated* to combine Kennedy with InfoGation and disclose transmitting information from a portal to a customer device over an FM subcarrier network for the obvious reason that FM subcarrier networks provide a simple, efficient and proven way to reach a large number of customer devices.

**As per claims Claim 24 and 31**, Kennedy discloses requesting an emergency 911 service to the Public Service Answering Point using the telematics device. See, for example, Col.5, line 47-59.

***As per claims Claim 25 and 32***, Kennedy discloses transmitting medical information of a customer to one or more telematics service providers during a medical roadside emergency.

***As per claims Claim 26 and 33***, Kennedy ***does not*** specifically disclose that a Public Service Answering Point may comprises an emergency medical service vehicle. Suman discloses transmitting medical information, stored in an on-board database, from a vehicle's telematics device to an emergency vehicle. See, for example, at least Col. 13, lines 15-54. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kennedy and Suman to disclose transmitting medical information from an onboard database to a PSAP/emergency medical service vehicle. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Kennedy and Suman to disclose transmitting medical information from an onboard database to a PSAP/emergency medical service vehicle for the obvious reason that it is important that emergency medical personnel have the latest medical information of a patient during a roadside emergency. A patient's virtual garage may exclude recent updates to a person's medical records, such a recently diagnosed diabetic condition. Medical personnel may alter their treatment according to such updates.

### ***Response to Arguments***

Applicant's arguments filed 26 March 2004 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's after-final amendment and response were not entered and applicant did not raise those issues in his request for continued examination. Nevertheless, the Examiner will take this opportunity to address several of applicant's comments.

Applicant argues that one of ordinary skill would understand the terms "medical log" and "medical roadside emergency" to include features introduced in applicant's after-final amendment and response. In response to this comment, it has been found "That a person skilled in the art might realize from reading the disclosure that such a particular definition (as now argued) is a possible definition is not a sufficient indication to that person that that particular definition is part of Applicant's invention as originally filed. Claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the examination of a patent application. In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). In the instant case, Applicant has not persuasively demonstrated that the Examiner has applied an unreasonable interpretation of the recited feature, that the interpretation is inconsistent with the specification, or that applied interpretation is repugnant to one of ordinary skill in the art.

As noted previously, the claims refer to "medical log" of a customer. While the term is mentioned in various places, applicants do not define what information is contained in the medical log. The term "medical log" will be continue to be given its

broadest reasonable interpretation to include *any* type of information concerning a customer's health, including any type of medical information or history. Similarly, the term "medical roadside emergency" will be given its broadest reasonable interpretation to include any type of situation where a customer feels he has need of *any* type of medical care.

Applicant argues that the various references fail to teach or suggest storing a medical log in an on-board database, and states that Kennedy's database 122:

...is clearly not an on-board database (see Fig. 1)... The Examiner incorrectly associated a database that is not part of the telematics device as the same database for storing a medical log, as required in Applicant's claimed invention. The database in the claimed invention is part of the telematics device included in the vehicle.

The Examiner again respectfully notes that while the Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Once more, it is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner. In one example, Further reading in Kennedy, however, discloses memory 40, Fig. 1. Memory 40 is shown as being inside car, item 25. Related text, Col. 4, line 46-Col. 5, line 3, describes that memory 40 includes various databases that store information for its various functions. These databases are *on-board databases, since they are on-board car 25*. In Suman, please see at least references to item 27, Fig. 3 and related text. Fig.3 is a

diagram of what is inside a car. Item 27 is a database inside the car: it is an *on-board database*. Please also see new matter rejection under 35 USC § 112.

A "traverse" is a denial of an opposing party's allegations of fact.<sup>2</sup> The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made, or Examiner's interpretation of teachings found in the references that disclose applicant's invention.

Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

The Examiner respectfully notes that where applicant **does not** seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ

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<sup>2</sup> Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

239 (CCPA 1943). [MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art]. Consequently, at least the following are admitted prior art:

...one can centralize a customer's needs for various services and provide seamless integration of personalized information, regardless of its source and means of transmission. Combining ordinary Internet electronic commerce applications, "life management" applications and telematics services permit a customer to simplify his access to computing resources. It is *well known* that customers may get confused when they are called on to remember how to access different services from multiple providers. By combining personalized services and information, a company can offer to reduce complexity for a customer. A company may offer single-billing services for all of the services provided, thereby reducing paperwork and billing complexities. Page 7 of previous office action.

...during medical emergencies, critical information such as a person's medical information may enable emergency medical personnel to diagnose a person's condition more quickly. Given information such as a person's allergic reaction to certain medications, for example, EMT crews may avoid administering those medications. Page 10 of previous Office Action.

...It is *well known* that this type of personalized information needs to be updated periodically. For example, if a customer retrieves vehicle location that has not been updated from before, the customer may not be able to tell if he is traveling in the right direction. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to transmit updates from TSPs. One of ordinary skill at the time the invention was made would have been *motivated* to transmit updates from TSPs for the obvious reason that customers need information that is reliable and in tune with their actions. For example, personalized information concerning rush-hour traffic congestions would be useless if a TSP transmits information that has not been updated from before. Customers may cease to rely on a provider and take their business elsewhere. This loss of business, if generalized, may well cause TSPs and portals to go bankrupt if they do not transmit updates. Page 8 of previous Office Action.

...It is well known that information may be transmitted from TSP's to telematics devices via FM subcarrier networks. For example, InfoGation discloses that CUE's FM subcarrier network reaches over 80% of the North American population and interstate highway system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Wireless Internet with InfoGation and disclose transmitting information from a portal to a customer device over an FM subcarrier network. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Wireless Internet with InfoGation and disclose transmitting information from a portal to a customer device over an FM subcarrier network for the obvious reason that FM subcarrier networks provide a simple, efficient and proven way to reach a large number of customer devices. Page 11 of previous Office Action.

In response to applicant's argument that the references "...address a completely different problem than [sic] Applicant's claimed invention..." and that his invention is intended to address "...particular problem of transmitting, retrieving and storing a

medical log on the on-board database for quick and efficient access by the emergency medical personnel and or the operator," the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Companies Jumping at GPS-wireless market opportunities for personal location, E-911." Global Positioning and Navigation News, Potomac, October 7, 1998, Vol. 8, Iss. 20, page 1.

"Holiday Autos/OnBoard Help/Concierge Systems/They can send aid, find a stolen car and make reservations." Shuldiner, Herb. Newsday, Long Island, NY, 27 December 1998. p. H11.

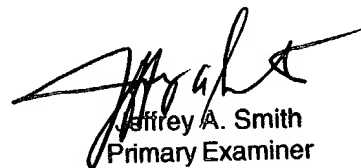
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
14 May 2004

  
Jeffrey A. Smith  
Primary Examiner